

REMARKS

Claims 1-11 are pending in this patent application. Applicants have amended claims 1, 5 and 8, and have entered new claim 11. As originally filed, claim 1 recited two alternative embodiments of the invention: (1) application of a conductive primer layer before shaping a substrate; and (2) application of a conductive primer layer after shaping a substrate.

Amended claims 1 and 5 and new claim 11 recite these two alternatives more clearly.

Additionally, Applicants have amended claim 1 to clarify the nature of the third coating layer of the protective and decorative laminar structure, and have amended claim 8 to correct its form. Support for the claims, as amended, is found in claim 1, as originally filed, and, additionally, in the specification at page 22, lines 28-30 and pages 24-25. No new matter has been added. Reconsideration and allowance of this patent application are respectfully requested in view of the above amendments and the following remarks.

Applicants understand that because this application is currently under final rejection, entry of this amendment is at the Examiner's discretion. However, Applicants respectfully submit that entry of this amendment would not require a substantial amount of additional work. Additionally, Applicants submit that this Amendment is necessary and was not earlier presented because it is made, at least in part, to arguments raised in the Office Action. Therefore, Applicants respectfully request entry of this amendment.

Claims 1-10 were rejected under 35 U.S.C. § 103(a) over Soltwedel et al., U.S. Patent No. 5,624,978, in view of Matsuo et al., U.S. Patent No. 5,190,830, and in view of the Merriam-Webster's Collegiate Dictionary definition of the term "plastic." Applicants respectfully traverse this rejection for at least the following reasons.

In making the rejection, the Examiner asserts that Soltwedel et al. discloses electrically conductive primer compositions, and that Matsuo et al. discloses the use of resins as materials for "topcoats." The Examiner then asserts that "[it] would have been obvious

to...have modified SOLTWEDEL's teachings as suggested by MATSUO and the dictionary because the selection and the use of thermoplastic or thermosetting polymers as materials in the topcoats would have been within the level of ordinary skill in the art."

Applicants respectfully disagree with the Examiner's assertions. However, in order to expedite the prosecution of this application, Applicants have amended claim 1 to specify the nature of the plastic film and its application. As amended, claim 1 recites the task of "bonding a thermoplastic film as a third coating layer of the protective and decorative laminar structure." As is explained in the instant specification at page 25, lines 4-10, "application [of the third coating layer] preferably involves an adhesive bond, which may optionally be promoted by suitable measures [...] Adhesive bonding may be achieved by using a hot-melt adhesive, aqueous dispersion adhesive or a solvent-based adhesive or the plastic films [may be] self-adhesive."

Applicants respectfully submit that the cited references do not disclose the task of "bonding...a thermoplastic film," as recited in claim 1, either alone or in combination. As the Examiner admits, Soltwedel et al. does not disclose any particular final coatings or layers that may be used with the base coating disclosed in the reference. Instead, Soltwedel et al. merely states, in column 14, lines 65-67, that "many commercially available primers and topcoat compositions are available and can be applied over the basecoat compositions of this invention."

With respect to Matsuo et al., irrespective of the type of "plastic" resins that the reference may generally disclose, Matsuo et al. does not disclose or suggest bonding a thermoplastic film as a third or top coating layer. In making the rejection, the Examiner asserts that the reference discloses the application of a topcoat at column 6, lines 47-57. However, Applicants submit that this passage merely discloses that a polyester-melamine topcoat resin composition "was...coated to a dry thickness of 30 to 35 μ and baked at 140°C

for 20 minutes" (emphasis added). Applicants note that the topcoat layer of Matsuo et al. is not bonded.

Accordingly, Applicants submit that claim 1, and the claims depending from claim 1, would not have been obvious over the cited combination of references. Therefore, Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, Applicants submit that this application is in condition for allowance. Timely notice to that effect is respectfully requested. If questions relating to patentability remain, the Examiner is encouraged to contact the undersigned to discuss the same.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned **"Version with markings to show changes made"**.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By Andrew McAleavey
Paul Sharer
Reg. No. 36,004
Tel: (703) 905-2180
Fax: (703) 905-2500

Andrew McAleavey
Reg. No. 50,535
Tel: (703) 905-2141
Fax: (703) 905-2500

PLS:AJM:ksh

1600 Tysons Boulevard
McLean, Virginia 22102
(703) 905-2000

Attachment: APPENDIX (p. 6)

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please amend claim 1 as follows:

1. (Four Times Amended) A process for the production of a three-dimensional substrate provided with a protective and decorative laminar structure, comprising:

applying a primer layer of a coating composition [(I)] which is electrically conductive in the stoved state without spraying onto an electrically conductive substrate and stoving said primer layer [prior to shaping the substrate in the desired three-dimensional shape];

electrophoretically depositing a second coating layer of an electrophoretically depositable coating composition [(II)] and stoving said second coating layer; and

[applying] bonding a [plastic] thermoplastic film as a third coating layer of the protective and decorative laminar structure;

wherein said plastic film, either alone or in conjunction with the second coating layer, determines the decorative effect of the laminar structure.
5. (Thrice Amended) A process according to claim 1, further comprising,

[subsequently applying and stoving the conductive primer layer] after applying and stoving the conductive primer layer, optionally stamping or cutting said substrate; and

shaping the substrate three-dimensionally.
8. (Twice Amended) A process according to claim 1, [comprising coating motor vehicles or the components thereof] wherein said substrate is a motor vehicle or a component thereof.